REMARKS

Reconsideration of this application is respectfully requested in view of the following remarks. Claims 1-24 are pending in this application and subject to examination.

In the Office Action mailed July 28, 2006, claims 1-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,320,947 to Joyce *et al.* ("Joyce") in view of U.S. Patent No. 6,430,276 to Heckard *et al.* ("Heckard") in view of U.S. Patent No. 5,684,965 to Pickering. The Applicant hereby traverses the rejection, as follows.

Claims 1, 6, 11, 16 and 21 Recite Patentable Subject Matter

Regarding claims 1, 6, 11, 16 and 21, the Applicant respectfully submits that nothing in the cited art, taken alone or in combination, discloses or suggests at least the combination of features of the present invention of "a billing facility configured to permit said user(s) to establish a billing allocation scheme **between a first party and second party** to be used to control the billing of services that are provided within said access controlled environment, and to . . . generate and process billing data based at least on said billing allocation scheme, wherein said billing data indicates a first monetary amount associated **with said services, which is to be billed to the first party**, and a second monetary amount associated **with said services, which is to be billed to the second party**, wherein each of the first monetary amount and the second monetary amount are **an amount greater than zero**, and the first party is **different than** the second party," as recited in claims 1, 6, and 21, and in the similar language of claims 11 and 16 (Emphasis added).

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The Applicant submits that both the case law of the Federal Circuit and the PTO itself have made clear that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three (3) criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success regarding the proposed combination of references. And third, the prior art references must **disclose or suggest all of the claim limitations**. *See* MPEP 2143 (Emphasis added). "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *Id.*; s*ee also, In re Royka*, 490 F.2d 981 (CCPA 1974). If the Office Action does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. *See* M.P.E.P. § 2142.

The Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness at least because the Examiner failed to show that the cited prior art discloses or suggests each and every limitation recited in claims 1-24 of the present invention.

Regarding each of claims 1, 6, 11, 16 and 21, the Office Action acknowledges that Joyce fails to teach the feature of the present invention of "a billing facility configured to permit said user(s) to establish a billing allocation scheme between a first party and second party to be used to control the billing of services that are provided within said access controlled environment, and to . . . generate and process billing data based at least on said billing allocation scheme, wherein said billing data indicates a first monetary amount associated with said services, which is to be billed to the first

party, and a second monetary amount associated with said services, which is to be billed to the second party," as recited in claims 1, 6, and 21, and the similar language of claims 11 and 16. *See* Office Action, at pages 2-3, 6, 9, 12 and 14-15.

The Office Action takes the position that Heckard corrects this deficiency in Joyce by:

> providing algorithms for masking the location point of a subscriber within a wireless communications network, so that knowledge of the resultant masked point or a plurality of masked points is insufficient to infer the actual location of the subscriber. At the same time, the range of inaccuracy is limited to a predetermined target region to allow the network provider to control performance, access, billing, call monitoring, and network resource allocation within acceptable limits. . . . The invention further includes multiple masking methods to reduce vulnerabilities associated with any particular method. (Note abstract and see column 1 lines 16-23 and column [sic] [lines] 56-67 and column 2 lines 1-4).

See, e.g., Office Action, at page 3.

The Applicant respectfully submits, however, that nothing in the cited passages of Heckard, or in the remainder of the reference, discloses or suggests the recited features of the present invention, which the Examiner acknowledged are missing from Joyce, namely, "a billing facility configured to permit said user(s) to establish a billing allocation scheme **between a first party and second party** to be used to control the billing of services that are provided within said access controlled environment, and to . . . generate and process billing data based at least on said billing allocation scheme, wherein said billing data indicates a first monetary amount associated **with said services, which is to be billed to the first party**, and a second monetary amount

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associated **with said services, which is to be billed to the second party**," as recited in claims 1, 6, and 21, and the similar language of claims 11 and 16.

It is submitted that Heckard discloses a method for concealing a mobile subscriber location information by using location area code regions and sub-regions. A first subscriber and a second subscriber in Heckard, however, cannot satisfy the limitations of the Applicant's claimed "first party" and "second party" because there is nothing in Heckard that discloses or suggests that users **are permitted to "establish a billing allocation scheme between a first party and second** party to be used to control the billing of services that are provided within said access controlled environment . . . wherein said billing data **indicates a first monetary amount associated with said services, which is to be billed to the first party, and a second monetary amount associated with said services, which is to be billed to the second party."**

Regarding each of claims 1, 6, 11, 16, 21, the Examiner acknowledges that Joyce and Heckard fail to explicitly teach that the billing of services is "associated with a particular transaction . . . wherein each of the first monetary amount and the second monetary amount are an amount greater than zero and the first party is different than the second party," as recited in claims 1, 6, and 21, and the similar language of claims 11 and 16. *See e.g.,* Office Action, at page 3.

However, the Examiner cites Column 6, lines 18-65 of Pickering as disclosing,

> Still referring to FIG. 4, if the customer instead remits $158.39, which is $13.80 less than the $172.19 total due, it can be assumed that the customer withheld the Part Due amount of $13.80 that was owed for payment of the previous month's Bell Telephone Company charge. In this instance, it

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is clear that customer intends to pay all current charges, but disputes a past charge.

Applicant respectfully submits that the cited portion of Pickering fails to cure the deficiencies of Joyce and Heckard because Pickering fails to disclose or suggest at least the limitations of "a billing facility configured to permit said [user or users] to establish a billing allocation scheme **between a first party and second party** to be used to control the billing of services that are provided within said access controlled environment, and to . . . generate and process billing data based at least on said billing allocation scheme, wherein said billing data indicates a first monetary amount associated **with said services, which is to be billed to the first party**, and a second monetary amount associated **with said services, which is to be billed to the second party**, wherein each of the first monetary amount and the second monetary amount are **an amount greater than zero**, and the first party is **different than** the second party," as recited in claims 1, 6 and 21 and the similar language of claims 11 and 16. (Emphasis added)

It is submitted that Pickering merely discloses <u>one</u> customer and the charges related to that one customer, rather than two parties being billed for services of the same transaction that is related to both parties of the present invention. Pickering provides only one party, i.e., the customer, who is to be billed or charged for services, and there can never be any inequitable distribution of expenses between parties involved in a single transaction because only the customer of the system is ever charged for services (the entity operating or providing the system does not charge itself

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for services which it provides to the user, and there are no other parties involved in the transaction).

Thus, there is *no need* in Pickering for a user to **establish a billing allocation scheme between at least two different parties involved in the same transactions** where the billing data indicates a first monetary amount associated **with said services of the transaction corresponding to said first party**, and a second monetary amount associated **with said services of the transaction corresponding to said second party**, as set forth in the Applicant's claimed invention, since the customer of Pickering is the only person of the transaction, and the billing for the customer is billed only to the customer. Moreover, because the charges are always billed to the single customer who used the service, there is no incentive to allow the customer to establish a billing allocation scheme between two different parties. As such, those of ordinary skill in the art at the time the invention was made would <u>not</u> have been motivated to modify the systems and methods described in Joyce, Heckard or Pickering to include the Applicant's claimed billing allocation scheme.

Thus, the combination of Joyce, Heckard and Pickering does not disclose or suggest the Applicant's claimed invention, as set forth in independent claims 1, 6, 11, 16, and 21. Therefore, the Applicant respectfully requests that the Examiner withdraw the obviousness rejection of independent claims 1, 6, 11, 16, and 21, and allow the same to issue in a U.S. patent.

As stated above, the Office Action bears the burden of establishing *prima facie* obviousness. M.P.E.P. § 2142. Therefore, for at least these reasons, the Applicant respectfully submits that the Office Action has failed to do so.

For at least these reasons, the Applicant submits that claims 1, 6, 11, 16 and 21 are allowable over the cited art.

Claims 2-5, 7-10, 12-15, 17-20 and 22-24 Recite Patentable Subject Matter

Regarding claims 2-5, 7-10, 12-15, 17-20 and 22-24, the Applicant respectfully submits that each of these claims depends from one of allowable claims 1, 6, 11, 16 and 21, and is therefore allowable for at least the same reasons.
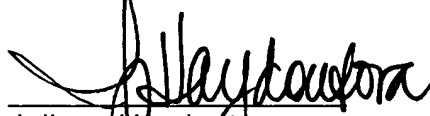
Conclusion

For all of the above reasons, it is respectfully submitted that the claims now pending recite patentable subject matter. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this

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communication to Deposit Account No. 01-2300, referring to client-matter number

026732-00009.

Respectfully submitted,

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Enclosure: Petition for Extension of Time (one month)

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